

REMARKS

Claims 1-5 and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species. Election was made without traverse in the reply filed on 04/09/07.

Claims 6-14 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hyodo et al.* (US-7,034,881, “*Hyodo*”) in view of *Yamazaki* (JP2002-0837456, “*Yamazaki*”).

Applicants have amended claims 6, 13,16, and cancelled claims 12 and 17. Claims 6 and 16 as amended incorporate the subject matter of cancelled claims 12 and 17, respectively. Claims 6-11, 13, 14, and 16 remain pending.

I. Regarding the rejections of claims 6-11, 13, 14, and 16 under 35 U.S.C. §103(a) as being unpatentable over *Hyodo* in view of *Yamazaki*

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 6-11, 13, 14, and 16. A *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, the prior art, taken separately or in combination, must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” USPTO Memorandum from

Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007,
page 2.

Here, a *prima facie* case of obviousness has not been established because, among other things, the prior art fails to teach or suggest each and every element recited by Applicants' claims.

Claim 6 recites a digital still camera comprising "when a touch operation in which the position does not change is detected . . . the control section continues to execute the reproduction process in accordance with the direction and speed while detecting the touch operation, and when the touch operation is not detected, the control section cancels the process in accordance with the direction and speed."

Hyodo does not teach at least this element of claim 6. *Hyodo* discloses, ". . . when the play button 18 at the lower left of the screen is touched to set the reproduction mode, the image data of the first frame stored in the image memory 32 is retrieved, and the image is reproduced. Then, the up button 21 and the down button 22 are touched so as to change frame numbers of frames to be reproduced," (column 8, lines 54-60 (emphasis added). *Hyodo* appears to disclose the use of play, up, and down buttons to control the reproduction of a stored image. *Hyodo*, however, does not teach or suggest the capability to "execute the reproduction process in accordance with the direction and speed while detecting the touch operation, and when the touch operation is not detected, the control section cancels the process in accordance with the direction and speed," as recited in claim 6.

Yamazaki fails to cure the deficiencies of *Hyodo*. The examiner cited paragraphs [0035]-[0039] in order to teach the elements not taught in *Hyodo*. These paragraphs do not teach these elements.

The applicants submit Paragraph [0023] of this reference discloses a generation means 15 set in a normal mode, a jog mode, or a shuttle mode through an operation button 16. Paragraph [0031] discloses a shuttle mode set by the operation button 16, the generation means 15 generates control signals S1 and S2 containing speed information by which reproduction is made at a rate according to the movement amount of an object contacting the surface of a pointing device 11.

As disclosed in paragraph [0033], when set in the jog mode by the operation button 16, the generation means 15 generates control signals S4 and S5 containing speed information by which reproduction is made at rate according to the speed of an object moving on the surface of the pointing device 11. Such reproduction is maintained while the object in contact with the surface.

As such, it is required to set the “mode” using the operation button 16 in the disclosure of *Yamazaki*. It is not until correct setting of the mode that desired reproduction is made possible in accordance with the movement amount and speed of the object moving on the surface of the pointing device 11. *Yamazaki* therefore, does not teach or suggest “execut[ing] the reproduction process in accordance with the direction and speed while detecting the touch operation, and when the touch operation is not detected, the control section cancels the process in accordance with the direction and speed,” as recited in claim 6.

Accordingly, no *prima facie* case of obviousness is established with respect to claim 6 because the prior art, either alone or in any proper combination, fails to teach or suggest each and every element recited in claim 1. Claims 7-11, 13, and 14 are also allowable at least due to their depending from claim 1.

Independent claim 16 although of different scope from claim 6, recites elements similar to those set forth above with respect to claim 6. Claim 16 is, therefore, allowable for at least the reasons presented above.

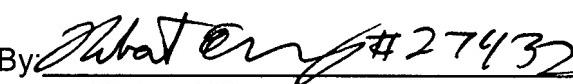
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 14, 2007

By: 
Richard Burgujian
Reg. No. 31,744
for